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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/538,408	10/24/2005	Masaaki Chiba	026390-00030	3607
4372	7590	01/09/2008		
ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER SY, MARIANO ONG	
			ART UNIT 3683	PAPER NUMBER
			NOTIFICATION DATE 01/09/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

Office Action Summary	Application No. 10/538,408	Applicant(s) CHIBA, MASAOKI	
	Examiner Mariano Sy	Art Unit 3683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 10-16 and 19-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/24/2005; 12/04/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election without traverse of Specie A, Figures 1-4, claims 1-9, 17, and 18 in the reply filed on November 15, 2007 is acknowledged. Claims 10-16 and 19-33 are withdrawn.

2. The information disclosure statement filed on October 24, 2005 (with a line across without Examiner's initials) fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

4. The disclosure is objected to because of the following informalities:

Page 5, line 10 "which4 has" should be --which has--.

Appropriate correction is required.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6. Claims 4, 8, and 9 objected to because of the following informalities:

Claim 4, line 2 "has such an outer diameter" should be --has an outer diameter--,

Claim 8, line 7 "and to thus cause" should be --and thus cause--,

Claim 9, line 1 "The direct acting type damping device claim 3" should be --The damping device as set forth in claim 3--.

Appropriate correction is required.

Drawings

7. The drawings are objected to because callout "105" should be --104-- ; and callout "104" should be --105-- for both Fig. 2(a) and Fig. 2(b). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief

description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 4, 7, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "these members are" in line 4. It is indefinite and unclear what Applicant is referring to.

Claim 7 recites the limitation "in its turn" in line 5. It is indefinite and unclear what Applicant is conveying.

Claim 8 recites the limitation "in its turn" in line 10. It is indefinite and unclear what Applicant is conveying.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 and 3-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers (US 4,651,623).

Rogers disclosed, as shown in fig. 1-2, a damping device comprising a housing and a flange member 15, 16 for damping arranged in the housing, wherein at least portions of the flange member apart from a center thereof are composed of an elastic material and inclined with respect to an axial direction and wherein the flange member, tapered towards peripheral edges on its both sides opposed to one another, is so designed that a peripheral face thereof is brought into contact with an inner wall of the housing.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubach (US 6,799,663).

Dubach disclosed, as shown in fig. 1-4, a damping device comprising a housing and a flange member 3 for damping arranged in the housing, wherein at least portions of the flange member apart from a center thereof are inclined with respect to an axial direction and wherein the flange member, tapered towards peripheral edges on its both sides opposed to one another, is so designed that a peripheral face thereof is brought into contact with an inner wall of the housing, see col. 4, lines 18-19.

However Dubach was silent to disclose wherein the flange member composed of an elastic material.

It would have been obvious to one of ordinary skill in the art to have made the flange member with an elastic material, since it is old and well known that an elastic material will provide a better seal when the piston moves within the housing in an axial direction.

14. Claims 9, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers in view of Pileggi (US 5,417,446).

Rogers teaches the use of a damping device but was silent to disclose wherein the device is attached to front suspensions for bicycles.

Pileggi disclosed an air damping for bicycle front suspensions.

Damping device used in bicycle front suspensions are old and well known, it would have been obvious to one of ordinary skill in the art to provide the damping

device of Rogers into the bicycle front suspensions, as taught by Pileggi, as a matter of design choice in order to effectively diminish shock due to road conditions.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stoll	(US 4,171,665)
Hopper	(US 4,337,956)
Kiesel	(US 5,941,162)
Thorn et al.	(US 6,386,528)
Larsen	(US 6,520,493)

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mariano Sy whose telephone number is 571-272-7126. The examiner can normally be reached on Mon.-Fri. from 8:30 A.M. to 2:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi, can be reached on 571-272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

 M. Sy

January 2, 2008



BRADLEY KING
PRIMARY EXAMINER

1/4/08